



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/694,582 | 10/23/2000 | Timothy M. Harris | Harris-1 | 3481 |

7590 01/26/2005

Denise M. Gosnell, Esq.
Woodard, Emhardt, Moriarty, McNett & Henry LLP
Bank One Tower/Center
111 Monument Circle, Suite 3700
Indianapolis,, IN 46204-5137

EXAMINER

BROWN, TIMOTHY M

ART UNIT

PAPER NUMBER

1648

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/694,582

Applicant(s)

HARRIS, TIMOTHY M.

Examiner

Timothy M. Brown

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Application/Control Number: 09/694,582
Art Unit: 1648

Page 2

DETAILED ACTION

This non-final Office action is responsive to the amendment mailed October 18, 2004. Claims 1-3 and 5-37 are under examination.

Claim Rejections - 35 USC § 112

Claim 37 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 37 provides that the claimed database stores certificates of analysis over time period that extends beyond the availability of the products. Although pages 20 and 21 of the specification describe searching for available chemical compound lot data and reserving chemical lots that are available, there is no disclosure of providing chemical compound lot data for products that are unavailable. A careful reading of the specification fails to reveal any other disclosure that describes the limitations of claim 37. Accordingly, claim 37 is rejected for failing to provide a written description of the invention as required by 35 U.S.C. 112, first paragraph.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Application/Control Number: 09/694,582
Art Unit: 1648

Page 3

Claims 1-3 and 5-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webber et al. (US 6,009,413) ("Webber") in view of "EM" ("EM Science Launches EMformation Web-based Catalog for Chemical Information and Ordering" Business Wire (April 13, 1998)) and further in view of Official Notice.

Regarding Claims 1, 2, 8-11, 16, 21-24 and 30, Webber teaches an online method and system for locating vendors for an item wherein a user submits a number of item criteria (col. 4, lines 4-8; and col. 5, lines 10-13 and 29-37). Users' access to the system is restricted via a security code (col. 3, lines 55-58). Upon entry of the security code and item criteria, users are presented with a list of vendors for the item wherein the list of vendors includes read only data item data (col. 4, lines 4-8; col. 5, lines 10-13 and 29-37; and col. 5, lines 45-56). According to Webber's system, vendors are permitted to upload product data on a periodic basis (col. 3, lines 10-24 and 58-61; col. 4, lines 11-13; and col. 5, lines 6-9).

Webber does not expressly teach providing chemical compound data information relating to chemical products that are available for sale. However, EM teaches an online system for sourcing chemicals wherein a user is permitted to submit chemical requirements including the product they are seeking including quantity (p. 1). EM also teaches permitting the user to select the chemical suppliers that are to provide chemical product data (Id.). At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Webber to include the teachings of EM. This combination would enable Webber's system to be applied to the procurement of chemicals.

Application/Control Number: 09/694,582
Art Unit: 1648

Page 4

Webber and EM do not expressly teach exchanging information for a specific lot. However, the Examiner takes Official Notice that exchanging information regarding the purchase of a specific lot of commodity or raw material is old and well known in the art. At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify Webber and EM to include exchanging information for a specific lot in order to provide for the procurement of commodities which vary in quality and composition.

Webber and Official Notice do not expressly teach receiving an electronic COA, and electronically displaying said COA in printable format. However, EM teaches an online method and system for providing chemical products including providing certificates of analysis, material safety data sheets and health and safety environmental data (p. 1). At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Webber and Official Notice to include receiving an electronic COA, and electronically displaying said COA in printable format in order to provide user with detailed product information thereby enabling users to make informed purchasing decisions.

Regarding Claims 3 and 31, Webber, EM and Official Notice teach all the limitations discussed under Claims 1, 2, 8-11, 16, 21-24 and 30. Webber and EM do not expressly teach accessing a server system via the Internet. However, the Examiner takes Official Notice that performing data exchange over the Internet is old and well known in the art. Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Webber and EM to include

Application/Control Number: 09/694,582
Art Unit: 1648

Page 5

accessing a server system via the Internet in order to provide a widely available communication means thereby increasing the potential number of users.

Regarding Claims 12, 13, 25 and 26, Webber, EM and Official Notice teach all the limitations discussed under Claims 1, 2, 8-11, 16, 21-24 and 30. Webber and EM do not expressly teach receiving the name of the purchase of a specific lot, receiving the chemical compound history tracking request, and generating a tracking history request for the chemical compound. However, the Examiner takes Official Notice that assessing the source of a commodity in making a purchasing decision is old and well known in the art of materials procurement. Assessing the source of a commodity enables purchasers to assess the quality of materials. Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Webber and EM to include receiving the name of the purchase of a specific lot, receiving the chemical compound history tracking request, and generating a tracking history request for the chemical compound.

Regarding Claims 14, 15, 27-29, Webber and EM teach all the limitations discussed under Claims 1, 2, 8-11, 16, 21-24 and 30. Webber and EM do not expressly teach receiving reservation data, storing reservation data, and sending an electronic confirmation message to a user. However, the Examiner takes Official Notice that reserving an item or service, in connection with an online transaction, and receiving a confirmation of such a reservation is old and well known in the art. Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Webber and EM to include teach receiving reservation data, storing

Application/Control Number: 09/694,582
Art Unit: 1648

Page 6

reservation data, and sending an electronic confirmation message to a user. This combination would enable a user to receive an assurance that a bargain has been completed such that the user will not have to seek performance of the bargain from another party.

Regarding Claims 5 and 18, Webber, EM and Official Notice teach all the limitations discussed under Claims 4 and 17. Webber and EM do not expressly teach receiving critical contaminant data from said users concerning contaminants of particular interest, and sorting said chemical compound lots. However, the Examiner takes Official Notice that taking chemical contaminants into consideration, when procuring chemicals for industrial uses, and ranking sources of chemicals according to the chemical contaminants, is old and well known in the materials procurement art. Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Webber, EM and Official Notice to include receiving critical contaminants data from said users concerning contaminants of particular interest, and sorting said chemical compound lots. This combination would enable users to obtain the best possible source for chemical compounds when users have a special use for said chemical compound.

Regarding Claims 6 and 19, Webber, EM and Official Notice teach all the limitations discussed under Claims 5 and 18. Webber, Official Notice and Savage do not expressly teach sending electronic messages to said users concerning receipt of additional chemical compound lot specification data. However, EM teaches an online method for the procurement of chemicals wherein a purchaser is permitted to

Application/Control Number: 09/694,582
Art Unit: 1648

Page 7

communicate with a chemical supplier (p. 1). Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Webber, EM and Official Notice to include sending electronic messages to said users concerning receipt of additional chemical compound lot specification data as this would enable users to finalize the procurement of chemical compounds.

Regarding Claims 7 and 20, Webber, EM and Official Notice teach all the limitations discussed under Claims 6 and 19. Webber and EM do not expressly teach sending electronic e-mail messages. However, the Examiner takes Official Notice that transmitting transaction data via e-mail is old and well known in the Internet commerce art. Therefore, at the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Webber and EM to include sending electronic e-mail messages in order to provide a convenient and widely accepted means of communication.

Regarding claim 17, Webber, EM and Official Notice do not expressly teach storing certificates of analysis over a historical period of time that extends beyond the availability of the product for purchase. However, the Examiner submits that EM made it obvious to include such a feature. This follows from the fact that EM's Web site serves as a "chemical knowledge provider" in addition to simplifying chemical purchasing (see e.g. p. 2, lines 12 and 13). Therefore, including information on chemicals that out of stock, or are otherwise unavailable, would have been obvious to one skilled in the Internet commerce art at the time of Applicants' invention.

Application/Control Number: 09/694,582
Art Unit: 1648

Page 8

Claims 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over "EM" ("EM Science Launches EMformation Web-based Catalog for Chemical Information and Ordering" Business Wire (April 13, 1998)).

Regarding claims 32-36, EM teaches an Internet procurement Web site having a database that stores a plurality of chemical data including certificates of analysis and related chemical compound lot specification data from a plurality of suppliers (p. 1). EM allows users to access and display detailed chemical data including certificates of analysis (Id.). EM does not expressly teach retrieving a second certificate of analysis of a second supplier based on input from a second user. However, EM posts product data from a number of distributors, and permits access to any customer having Internet access. Providing products from a number of distributors increases the value of EM's service since it provides customers with a greater product selection. Moreover, enabling multiple users to access EM's site simultaneously provides volume in site traffic and sales. Therefore, at the time of Applicant's invention, it would have been obvious to modify EM to include retrieving a second certificate of analysis of a second supplier based on input from a second user.

It is also important to note that EM does not expressly teach the first supplier and first user being located in different countries. However, as EM is directed to providing global access to product data via the Internet, it would have been obvious to permit users in different countries to utilize EM's communication medium for completing international financial transactions.

Application/Control Number: 09/694,582
Art Unit: 1648

Page 9

Regarding claim 37, Webber, EM and Official Notice teach all the limitations noted under claims 32-36. Webber, EM and Official Notice do not expressly teach storing certificates of analysis over a historical period of time that extends beyond the availability of the product for purchase. However, the Examiner submits that it would have been obvious to include such a feature as noted under claim 17.

Response to Arguments

Claims 1 and 16

Applicant argues the combination of Webber and EM fails to teach or suggest "providing a clearinghouse for historical chemical compound data" The Examiner notes this limitation (i.e. a clearinghouse) does not appear in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant's argument is therefore moot.¹

Claims 12, 13, 25 and 26

Applicant contests the Examiner's use of Official Notice asserting "the ability to find and assess the certificate of analysis and source of a chemical lot was a very time consuming [*sic*] process that was not available in a centralized clearinghouse fashion." Applicant further notes "certificates of analysis could *generally* only be obtained

¹ It is noteworthy that even if the claims required a clearinghouse, Webber would teach this feature nonetheless. This is because Webber discloses a Web site that collects product/service information from various sources" (abstract).

Application/Control Number: 09/694,582
Art Unit: 1648

Page 10

manually from an immediately prior supplier or only with great difficulty from an original source." Applicant's arguments do not overcome the assertion of Official Notice for the following reasons.

First, Applicant failed to seasonably challenge the assertion of Official Notice in the response mailed February 24, 2004. Thus, the teachings provided through Official Notice are admitted prior art according to MPEP § 2144.03. Second, as noted above, the claims do not require a clearinghouse. Thus, the Official Notice taken does not have to include this feature. Third, EM expressly demonstrates that contrary to Applicant's assertion, the Internet commerce art witnessed the online distribution of certificates of analysis prior to Applicant's invention. This follows from EM's disclosure wherein it is stated "the Emformation web-site [sic] provides easy access to . . . certificate of analysis (COA) data . . ." (p. 2, lines 23 and 24). For at least these reasons, Applicant's remarks fail to overcome the assertion of Official Notice.

Claims 32-36

Applicant argues EM fails to teach a number of limitations recited in claim 32. In particular, Applicant asserts EM fails to teach providing certificates of analysis for products from multiple suppliers. The Examiner respectfully disagrees.

It is worth noting that EM qualifies as a reference under 35 U.S.C. § 102(a). Thus, EM serves as evidence as to what "was known or used by others in this country" prior to Applicant's invention. An archive database hosting EM's product catalog demonstrates that providing certificates of analysis for products from multiple suppliers

Application/Control Number: 09/694,582
Art Unit: 1648

Page 11

was known prior to Applicant's invention. This is demonstrated in the attached printout of the archive file. This document expressly states that EM's catalog represented products from "four chemical businesses" Therefore, EM's practice of providing a catalog of products from separate chemical companies establishes that the limitations of claim 32 became public knowledge before Applicant's invention.

Applicant further argues that EM does not teach or suggest displaying current and historical certificates of analysis. However, this argument is moot in that claim 32 does not recite this limitation.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Application/Control Number: 09/694,582
Art Unit: 1648

Page 12

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Brown whose telephone number is (571) 272-0773. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on (571) 272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Timothy M. Brown
Examiner
Art Unit 1648

tmb


WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3800